

REMARKS

The non-final Office Action issued 12 May 2003 has been reviewed and the comments of the U.S. Patent and Trademark Office have been considered. Claims 21-24 have been added. Accordingly, Applicants request reconsideration of the pending claims 1-24.

Claims 1-20 stand rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 6,454,192 to Dallmeyer *et al* ("Dallmeyer"). Applicants respectfully traverse this rejection because Dallmeyer fails to teach or suggest the claimed invention as a whole, as recited in claims 1 and 10.

Claim 1 recites a method of manufacturing a fuel injector that can be achieved, in part, by assembling a fuel group by performing a series of processes in the following order: (a) inserting an adjusting tube into a fuel assembly; (b) inserting a biasing element into the fuel tube assembly; (c) inserting the armature assembly into the fuel tube assembly; and (d) connecting the seat assembly to the fuel tube assembly. Claim 10 recites a method of assembling a fuel group that can be achieved, in part, by assembling the fuel group by performing the following processes in the order recited: (a) inserting an adjusting tube into the fuel tube assembly; (b) inserting a biasing element into the fuel tube assembly; (c) inserting the armature assembly into the fuel tube assembly; and (d) connecting the seat assembly to the fuel tube assembly.

In contrast, Dallmeyer assembles a fuel group assembly opposite to the order (i.e., sequence) recited in claims 1 and 10. Specifically, Dallmeyer states, at column 8, lines 3-4, 15-16, 30-31, and 32-34, that a pre-assembled seat and guide assembly is loaded into a valve body before an armature assembly is loaded into the valve body. Thereafter, a spring is loaded into the valve body before a filter/adjusting tube is loaded into the valve body. Thus, the sequence of assembly of the fuel group assembly of Dallmeyer is in a different sequence, i.e., opposite to that

of the sequence recited in each of claims 1 and 10. Because the sequence of assembly in Dallmeyer is opposite the sequence recited in claims 1 and 10, Dallmeyer fails to teach or suggest the claimed invention as a whole. Accordingly, claims 1 and 10 are patentable over Dallmeyer.

Claims 1-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,454,192 to Perry in view of Dallmeyer. Applicants respectfully traverse this rejection because Perry and Dallmeyer, whether considered alone or in combination, fail to teach or suggest the claimed invention as a whole.

As discussed earlier, each of claims 1 and 5 recites the assembling of components in a fuel group in a specified sequence order of assembly. Perry and Dallmeyer fail to teach or suggest this specified sequence of assembly of the claimed invention as a whole. In particular, Perry assembles various fuel injector components into a unitary injector, and fails to teach or suggest an assembly of specified components in a specified sequence into a fuel group. Perry states, at column 3, lines 33-50, that a lower body 72 and coil assembly 20 are fitted onto an injector tube 12; an upper body 70 is fitted onto the tube 12 so that the upper body 70 and lower body 72 form a coil body assembly 20; and a cover 30 is molded over the coil body assembly and fuel tube 12 to form an injector 10. That is, Perry employs different components with a different sequence for assembly of these components as compared to components and sequence of assembly recited in each of claims 1 and 10. Dallmeyer, however, fails to cure the deficiencies of Perry because Dallmeyer, as discussed earlier, employs an order of assembly opposite that of the claimed invention as a whole, as recited in claims 1 and 10. Thus, absent the benefit of applicants' disclosure, there is no motivation or suggestion to assemble a fuel group of the claimed invention as a whole in the order recited. Accordingly, claims 1 and 10 are

patentable because Perry and Dallmeyer, whether considered alone or in combination thereof, fail to teach or suggest the claimed invention as a whole.

Notwithstanding these deficiencies in the proposed combination of Perry in view of the Dallmeyer, Applicants submit that Dallmeyer does not qualify as prior art, as provided for by 35 U.S.C. §103(c). As noted in MPEP § 2146, subject matter developed by another, which might qualify as “prior art” under 35 U.S.C. §102(e) is not to be considered pursuant to 35 U.S.C. §103(c) when determining whether an invention sought to be patented is obvious under 35 U.S.C. §103, provided that the subject matter and the claimed invention were commonly owned at the time the invention was made. Applicants respectfully note that Dallmeyer and the instant application are commonly owned (i.e., assigned) to the same assignee at the filing of the instant application, which was filed after November 29, 1999. Therefore, Dallmeyer is not applicable as prior art in the obviousness determinations by the Office Action under 35 U.S.C. § 103. Accordingly, claims 1 and 10 are patentable for at least this reason.

New dependent claims 21-24 have been added to particularly point out and distinctly claim applicants' invention. In particular, claims 21 and 23 recite that the assembling of the fuel group includes forming hermetic seal between an orifice disc and a surface of the seat assembly outside of the clean room. Support for this amendment to claims 21 and 23 is provided by the originally filed specification at, for example, page 11, line 15. Claims 22 and 24 recite that the connecting of the seat assembly includes welding through outer and inner surfaces of a valve body to the circumferential surface of the seat assembly so that a hermetic seal is formed between the inner surface of the valve body and the circumferential surface of the seat assembly. Support for this amendment to claims 22 and 24 is provided by the originally filed specification at, for example, page 10, line 15 and Figures 1 and 5A. Applicants respectfully submit that the

relied-upon prior fails to teach or suggest features recited in claims 21-24, inasmuch that claims 21-24 depend ultimately from one of allowable claims 1 and 10.

Claims 2-9 and 11-20 depend ultimately from a respective one of allowable claims 1 and 10, and are also allowable at least because claims 1 and 10 are allowable, as well as for reciting other features.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and allowance of the pending claims 1-24. Applicants respectfully invite the Examiner to contact the undersigned at (202) 739-5203 if there are any outstanding issues that can be resolved via a telephone conference.

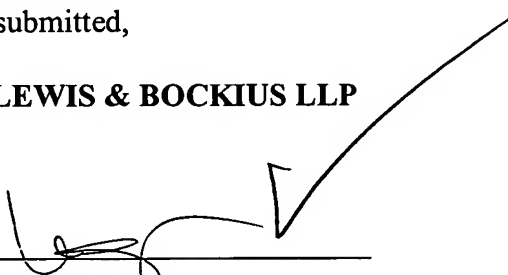
EXCEPT for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. §1.136(a)(3).

Respectfully submitted,

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